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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/904,516	07/16/2001	Nathalie Mougin	P 0281573 B00/2208 US	2271
909	7590	12/13/2004	EXAMINER	
PILLSBURY WINTHROP, LLP P.O. BOX 10500 MCLEAN, VA 22102			SHARAREH, SHAHNAM J	
			ART UNIT	PAPER NUMBER
			1617	

DATE MAILED: 12/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/904,516

Applicant(s)

MOUGIN ET AL.

Examiner

Shahnam Sharareh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 3/30/2004, 9/7/2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-28 and 30-33 is/are pending in the application.
- 4a) Of the above claim(s) 1-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 18-28 and 30-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 30, 2004 and September 7, 2004 have been entered.

Claims 1-33 are pending. Claims 1-17 stand withdrawn for the reasons of record filed on July 02, 2003. Claims 18-33 were subject to an election of species filed on March July 1, 2004.

Applicants' election of response to the species filed on September 7, 2004 is acknowledged. Accordingly, a search directed to the elected species wherein:

- R and R': a radical of C<sub>18</sub> H<sub>37</sub>OH,
- X and X': a radical of methylene dicyclohexyl diisocyanate,
- L, L' and L'': a radical of methylene dicyclohexyl diisocyanate,
- P and P': a radical of N-methylethanolamine,
- Y: a radical of polyethylene glycol.

A search was conducted directed to the species as elected. Accordingly, the scope of the claims to the extent that they read on the elected species are free of art. The search was then expanded to such species wherein n, m, p values are 0 and R and R' is a hydrophobic group, X and X' is an amine, L, L' and L'' are a diisocyanate derivative, P and P' are an amine functional group.

Applicant's arguments with respect to the election of species requirement have been considered but are not found persuasive. Applicant argues that the election of species at this stage of prosecution is unnecessary. In response Examiner states that the raising an election requirement is discretionary to further advance the prosecution. Further the scope of the instant claims have not been searched upto this point in the prosecution. In addition, applicant's arguments throughout the prosecution were not consistent with the scope of the claims. Therefore, the requirement is made to advance the prosecution for the purposes of identifying the novelty of the claimed invention.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 18-33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The recitation of L, L' and L" representing a "group derived from diisocyanate" is vague. It is not clear to what type of derivatives is applicant referring? The specification fails to explicitly explain what is the scope of such group. Accordingly, the metes and bound of the claims are not clear.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA

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1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 18-33 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 44 of U.S. Patent No. 6,602,303. Although the conflicting claims are not identical, they are not patentably distinct from each other because the both sets of claims are directed to cosmetic compositions that contain the same cationic polymer. The patented claims teach the scope of the instant claims. Accordingly, it would have been obvious to one of ordinary skill in the art at the time of invention to practice the scope of the instant claims when in possession of the patented compositions.

Claims 18-33 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 51-68 of copending Application No. 10/415952. Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims are directed to compositions that overlap in scope. The instant claims contain the same cationic polymers as taught in the co-pending application. Thus, it would have been obvious to one of ordinary skill in the art at the time of invention would have been able to practice the scope of the instant claims when in possession of the co-pending compositions.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 18-29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The recitation of L, L' and L" being a group "derived from diisocyanate" render the metes and bound of the claims vague, because it is not clear to which diisocyanate derivatives is applicant referring? The specification fails to exemplify or clearly set forth what is meant by this term. Accordingly, the recitation is deemed to be indefinite.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical

Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 18-19, 21-25, 27-28, 30-33 are rejected under 35 U.S.C. 102(b) as being anticipated by Laine US Patent 4,617,341.

The instant claims are directed to compositions comprising a cationic polyurethane.

Laine teaches cationic polyurethane their method of manufacture. (col 1-2). Laine teaches a variety of polymers that fall within the scope of the instant formula when n, m and p are 0. (see col. 1, line 46 through col. 2, line 36).

Terminal R1 groups of Laine is an aliphatic radical that meets the instant limitations of R and R' as they are hydrophobic. (see col 1, line 68-col 2, line 9). Note that the instant X or X' comprise a linear and branched alkylenes having 1 to 20 carbon atoms. R2 of Laine include alkylene radicals and is attached to a quaternary amine group that meets the requirement of the instant X or X'. Laine teaches an aromatic diisocyanate unit which falls within the scope of the instant L or L' as a diisocyanate derivative. R5 of Laine is a quaternary amine group that meets the limitation of the instant X or X'. Laine's polymer can have a molecular weight of 3000 which meets the limitations of the instant claim 23.

The starting materials include tertiary dialkylethanolamines (see col. 4, lines 1-45). The resulting polymers are dispersed in water. Water meets the requirement for

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cosmetically acceptable medium. Accordingly, Laine anticipates the limitations of the instant claims.

Claims 18-28, 30-33 rejected under 35 U.S.C. 102(e) as being anticipated by Bucks et al US Patent 6,277,364.

Bucks discloses cosmetic compositions comprising a polyurethane of formula(I). (see col 2, lines 15-45). The polymers of Bucks falls within the scope of the instant claims.

The formula (I) of Bucks comprises the following functional groups that correspond to the instantly claimed functional groups when Bucks' n is 0 as claimed in claim 9-12.

Instantly claimed functional groups	Corresponding Functional groups in '364	Citations
R and R'	Terminal -H	Col 20, lines 5-10.
X and X'	Y is -NR', R' is a lower alkyl or H	Col 20, lines 17-20.
L, L, L"	-OC(O)NH	Col 20, lines 5-10.
P and P'	Y is -NR', R is a lower alkyl or H	Col 20, lines 17-20.
Y	X is lower alkoxy, nitro or amino, etc..	Col 20, lines 17-19.
n	m	

Bucks' polymer further has the molecular weights that fall within the scope of the instant claims. (see col 22, lines 10-14). Accordingly, Bucks polymers anticipate the limitations of the instant polymers.

### **Conclusion**

No claims are allowed. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shahn timer Sharareh whose telephone number is 571-272-0630. The examiner can normally be reached on 8:30 am - 6:00 pm.



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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreenivasan Padmanabhan, PhD can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SS

SHENGJUN WANG  
PRIMARY EXAMINER  
